Remarks:

Regarding the Restriction Requirement:

The applicant thanks the Examiner for extending the search to encompass the following indicated species of deactivants: citrus oil, orange oil, terpene hydrocarbon and β-pinene as noted at page 2 of the Office Action.

In this paper, the applicant cancels the following species of deactivants from the claims: a mint oil, bois de rose oil, oil of jasmine, frankincense, oil of bergamot, and oil of lemon grass.

The applicant expressly reserves the right to reinstate any presently canceled subject matter in a later filed divisional or continuation application.

Regarding the provisional "obviousness type" double-patenting rejection in view of copending application US Serial No. 10/595767:

The applicant traverses the Examiner's present requirement and the "double patenting" rejection as being untimely and thus inappropriate. No claims in the present application have been deemed to be allowable, and it is noted that no claims in the 10/597767 application have also been deemed allowable. Thus it is believed that the Examiner's requirement is both premature, and inequitable to insist upon the entry of a Terminal Disclaimer at the present date which would unfairly compromise the applicant's potential interest in scope of patent protection in both of the currently co-pending applications. Upon indication of allowable subject matter in either application, the applicant will be in a better position to comply with the mandates of MPEP § 822 and requests that the Examiner reinstate the present rejection at such later date, should the basis for such a rejection be considered appropriate.

Regarding the provisional "obviousness type" double-patenting rejection in view of copending application US Serial No. 10/595463:

The applicant traverses the Examiner's present requirement and the "double patenting" rejection as being untimely and thus inappropriate. No claims in the present application have been deemed to be allowable, and it is noted that no claims in the 10/597463 application have also been deemed allowable. Thus it is believed that the Examiner's requirement is both premature, and inequitable to insist upon the entry of a Terminal Disclaimer at the present date which would unfairly compromise the applicant's potential interest in scope of patent protection in both of the currently co-pending applications. Upon indication of allowable subject matter in either application, the applicant will be in a better position to comply with the mandates of MPEP § 822 and requests that the Examiner reinstate the present rejection at such later date, should the basis for such a rejection be considered appropriate.

Regarding the rejection of claims 1, 3-8, and 11-17 under 35 USC 102(b) in view of GB 2367243, (hereinafter simply the "GB243" reference):

The applicant traverses the Examiner's rejection of the indicated claims as allegedly being anticipated by the GB243 reference.

Prior to discussing the relative merits of the Examiner's rejection, Applicants point out that unpatentability based on "anticipation" type rejection under 35 USC 102 requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada,* 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus, when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

At page 2 thereof, GB243 cites the following as the gist of its invention:

> We have now discovered that the house dust mite Der-p allergen can be denatured by burning candles containing certain natural oils to deactivate the allergens.

Accordingly, the present invention provides a method for deactivating a Der-p allergen which comprises burning in a space to be treated a candle comprising a deactivating amount of a volatile oil selected from cajeput oil (tea tree oil) or an oil comprising one or more monocyclic terpene hydrocarbons.

The applicant traverses the Examiner's rejection of the claims, as the disclosure of GB243 fails to disclose the subject matter of the claims. The GB243 reference is wholly silent as to any long term effects of the use of its compositions and processes. The Examiner has failed to provide any documentation or other showing to support the Examiner's presupposition that the claimed properties would be inherent or would be both recognized and understood by a skilled artisan. The Examiner has failed to meet their burden of proof. A rejection under 35 USC 102(b) cannot be based on a presumption or conjecture. See *Hitzeman v. Rutter,* 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson,* 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency). See also *Trintec Indus., Inc. v. Top-U.S.A. Corp.,* 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002); *W.L. Gore v. Garlock, Inc.,* 721 F.2d at 1554 (Fed. Cir. 1983)

Accordingly reconsideration of, and withdrawal of the outstanding rejection is solicited.

Regarding the rejection of claims 1. 3-8, and 11-17 under 35 USC 102(b) in view of WO 01/76371 (hereinafter referred to as "WO371"):

The applicant respectfully traverses the Examiner's rejection of the indicated claims in view of the WO371 reference.

The applicant traverses the Examiner's rejection of the claims, as the disclosure of WO371 fails to disclose the subject matter of the claims. The disclosure of the WO371 reference is similar to that of the prior GB243 reference. The gist of the WO371 document is found at the following passages from pages 2 and 3:

> We have now discovered a group of novel allergen denaturants for the house dust mite Der-p allergen which are derived from natural oils and can be delivered as a vapour to deactivate the allergens.
>
> Accordingly, the present invention provides a method of deactivating a Der-p and/or Der-f allergen which comprises volatilizing into a space to be treated a deactivating amount of a volatile oil selected from cajeput oil (tea tree oil) or an oil comprising one or more terpene hydrocarbons.
>
> The volatile oil may be volatilised by the use of heat to vaporize the oil. For example the volatile oil may be floated on water in an oil burner or heated directly in an oil burner. Alternatively the volatile oil may be vaporized from a heated wick dipped into a reservoir of the volatile oil.

Another method of volatilizing the volatile oil is from an ultra-sonic jet nebuliser which contains water with the volatile oil floated on the surface of the water.

A further method of volatilizing the volatile oil is by the ventilation of a source of the volatile oil using an ion wind. An ion wind generates an ionized air flow which facilitates the evaporation and dispersal of the volatile oil into the air. A unipolar charge is transferred to the molecules of the oil which is evaporated. Optionally the source of the

However, as in the prior GB243 reference, the WO371 reference is wholly silent as to any long term effects of the use of its compositions and processes. The Examiner has failed to provide any documentation or other showing to support the Examiner's presupposition that the claimed properties would be inherent or would be both recognized and understood by a skilled artisan. The Examiner has failed to meet their burden of proof. A rejection under 35 USC 102(b) cannot be based on a presumption or conjecture. See *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency). See also *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002); *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983)

Accordingly reconsideration of, and withdrawal of the outstanding rejection is solicited.

Regarding the rejection of claims 1, 9, 11 and 18 under 35 USC 103(a) in view of GB 2367243 (the "GB243" reference), WO 01/76371 (the "WO371" reference) each in view of WO 03/070286 (hereinafter referred to as the "WO286" reference):

The applicant traverses the rejection of the indicated claims in view of the GB243 reference in view of the WO286 reference. The applicant also traverses the rejection of the indicated claims in view of the WO371 reference in view of the WO286 reference.

The rejections are rendered moot in view of the applicant's presently amended claims which cancel prior claims 3 and 12 each of which had not been rejected by the Examiner, and incorporating the limitations of these canceled claims into independent claims 1 and 11, respectively.

Accordingly reconsideration of, and withdrawal of the outstanding rejection is solicited.

Regarding the rejection of claims 1, 10 - 11 and 19 under 35 USC 103(a) in view of GB 2367243 (the "GB243" reference), WO 01/76371 (the "WO371" reference) each in view of US 6500445 to Pullen (hereinafter referred to as the "Pullen" reference):

The applicant traverses the rejection of the indicated claims in view of the GB243 reference in view of the Pullen reference. The applicant also traverses the rejection of the indicated claims in view of the WO371 reference in view of the Pullen reference.

The rejections are rendered moot in view of the applicant's presently amended claims which cancel prior claims 3 and 12 each of which had not been rejected by the Examiner, and incorporating the limitations of these canceled claims into independent claims 1 and 11, respectively.

Accordingly reconsideration of, and withdrawal of the outstanding rejection is solicited.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

PETITION FOR A ONE-MONTH EXTENSION OF TIME

Applicants respectfully petition for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, including any extension of time fees, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;

Andrew N. Parfomak, Esq. Date: 08.Feb.2010

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CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper and all attachments thereto is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571 273-8300 on the date shown below:

Andrew N. Parfomak

08.FEB.2010

Andrew N. Parfomak Date:

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